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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,572	07/05/2000	Shigeru Tamai	P107344-00002	4419

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EXAMINER

HAWKINS, CHERYL N

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

Office Action Summary

Application No.

09/610,572

Applicant(s)

TAMAI ET AL.

Examiner

Cheryl N Hawkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 7,9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claim 7 is objected to because of the following informalities: "indicting" in line 15 of the claim should be marked --indicating-- . Appropriate correction is required.
2. Claim 9 is objected to because of the following informalities: "indicting" in line 17 of the claim should be marked --indicating-- . Appropriate correction is required.
3. Claim 10 is objected to because of the following informalities: "indicting" in line 15 of the claim should be marked --indicating-- . Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Is the applicant claiming just the transfer head or the transfer head on a transfer tool?
6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. Claims 1, 7, 9, and 10 recite the limitation "the coat film transfer tool" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al. (US 5,556,469) in view of Nishikawa et al. (US 3,804,055) and Mendelovich et al. (US 5,904,806). Koyama et al. discloses a coat film transfer head device (coating film transfer head H) disposed at the leading end portion of a coat film transfer tool (Figure 1) for pressing a coat film transfer tape (coating film transfer tape T) onto an object of transfer which includes a head main body for pressing and transferring the coat film transfer tape (head body 35 and pressing part 35a); a head holder for supporting the head main body rotatably about its axial center (semi-cylindrical portions 3c and 4c and bearing part 36); and a rotating operation unit for positioning the head main body in the rotation direction (rotative part R). Koyama et al. also discloses a coat film transfer head device in which the rotating operation unit includes an operation lever (Figure 9a, engagement projection 46) related to the tape pressing and transferring position of the head main body and the operation lever projects into an operation guide (positioning part 41) in a slit form (anchor guide groove 41b) on an inside portion of the case.

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As to Claims 1 and 2, Koyama et al. does not disclose a device in which the rotating operation unit serves also as a head position indicating unit for indicating the tape pressing and transferring position of the head main body or an operation lever projecting through the operation guide to the outside of the case. It is well known and conventional in the mechanical device art, as disclosed by Nishikawa et al. (Figure 1, lever 2), to supply a device with a lever which provides means for moving particular elements contained within the device as well as means for clearly indicating the position of those particular elements. Mendelovich et al. discloses a tape dispensing applicator in which an operation lever projects to the outside of a case through an operation guide in a slit form penetrating through the case of the applicator (column 17, lines 42-48). The inability to clearly identify the position of the coat film transfer head of Koyama et al. would have been readily apparent to one of ordinary skill in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the operation lever of Koyama et al. to allow it to project to the outside of the case; the projection of the lever to the outside of the case providing an easier method for a user to operate the lever actuating device and gauge the position of the transfer head at any given time.

As to Claim 3, Koyama et al. discloses a coat film transfer head device in which the operation guide (positioning part 41) in a slit form (anchor guide groove 41b) defines the operating range in the rotating direction of the operation lever and controls the tape pressing and transferring position of the head main body (column 8, lines 43-54; column 9, lines 41-49).

As to Claim 4, Koyama et al. discloses a coat film transfer head device in which the head holder includes a cylindrical supported portion (lower part 44b and semi-cylindrical portions 3c,

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4c) provided concentrically and integrally with the head main body (head body 35) and a cylindrical bearing (bearing part 36) provided at the device main body side for supporting the supported portion (column 7, lines 53-67; column 8, lines 1-15).

As to Claim 5, Koyama et al. discloses a coat film transfer head in which the supported portion is formed in an arc section having a setting opening (through hole 44) for coat film transfer tape to the head main body (Figure 8; column 8, lines 32-42).

As to Claim 8, Koyama et al. discloses a coat film transfer head device which includes positioning means for positioning and holding the head main body at plural steps around its axial center (column 2, lines 46-52; column 9, lines 41-49).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al. (US 5,556,469), Nishikawa et al. (US 3,804,055), and Mendelovich et al. (US 5,904,806) as applied to claim 1 above, and further in view of Blau (DE 43 24 383 A1). Koyama et al. discloses a coat film transfer head which includes positioning means for positioning and holding the head main body in steps around its axial center (column 2, lines 46-52; column 9, lines 41-49). Koyama et al. is silent as to the head main body being positioned and held steplessly around its axial center. It is well known in the apparatus art, as disclosed by Blau (abstract), for mechanical elements to be positioned in a stepless manner to provide for fine adjustment of the elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the positioning and holding means of the coat film transfer head of Koyama et al. to function steplessly thereby finer adjustments can be made to the angle of the transfer head device to adapt the device for a variety of users and uses.

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10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al. (US 5,556,469) in view of Nishikawa et al. (US 3,804,055) and Mendelovich et al. (US 5,904,806). Koyama et al. discloses a refill type coat film transfer tool (column 15, lines 11-19) capable of replacing the coat film transfer tape in which a tape cartridge (tape cartridge C) containing a rotatable pay-off reel (pay-out reel 6) on which a coat film transfer tape is wound, and a rotatable take-up reel (winding reel 7) for collecting the used coat film transfer tape is detachably provided in a case which is held in one hand, coat film transfer head means for pressing the coat film transfer tape onto the object of transfer (coating film transfer head H) is attached to the leading end portion of the tape cartridge (Figure 1), the coat film transfer head means includes a head main body for pressing and transferring the coat film transfer tape (head body 35 and pressing part 35a), a head holder for supporting the head main body rotatably about its axial center (semi-cylindrical portions 3c and 4c and bearing part 36), and a rotating operation unit for positioning the head main body in the rotating direction (rotative part R).

Koyama et al. does not disclose a device in which the rotating operation unit functions also as the head position indicating unit for indicating the tape pressing and transferring position of the head main body. Koyama et al. does not disclose a device in which the rotating operation unit serves also as a head position indicating unit for indicating the tape pressing and transferring position of the head main body or an operation lever projecting through the operation guide to the outside of the case. It is well known and conventional in the mechanical device art, as disclosed by Nishikawa et al. (Figure 1, lever 2), to supply a device with a lever which provides means for moving particular elements contained within the device as well as means for clear

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indicating the position of those particular elements. Mendelovich et al. discloses a tape dispensing applicator in which an operation lever projects to the outside of a case through an operation guide in a slit form penetrating through the case of the applicator (column 17, lines 42-48). The inability to clearly identify the position of the coat film transfer head of Koyama et al. would have been readily apparent to one of ordinary skill in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the operation lever of Koyama et al. to allow it to project to the outside of the case; the projection of the lever to the outside of the case providing an easier method for a user to operate the lever actuating device and gauge the position of the transfer head at any given time.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al. (US 5,556,469) in view of Nishikawa et al. (US 3,804,055) and Mendelovich et al. (US 5,904,806). Koyama et al. discloses a disposable coat film transfer tool using a one-time coat film transfer tape (column 15, lines 11-19) in which a pay-off reel (pay-out reel 6) on which a coat film transfer tape is wound, and a take-up reel (winding reel 7) for collecting the used coat film transfer tape are provided in a case which is held by one hand (Figures 11a and 11b), coat film transfer head means for pressing the coat film transfer tape onto the object of transfer (coating film transfer head H) is attached to the leading end portion of the case, the coat film transfer head means comprises a head main body for pressing and transferring the coat film transfer tape (head body 35 and pressing part 35a), a head holder for supporting the head main body rotatably about its axial center (semi-cylindrical portions 3c and 4c and bearing part 36),



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and a rotating operation unit for positioning the head main body in the rotating direction (rotative part R).

Koyama et al. does not disclose a device in which the rotating operation unit functions also as the head position indicating unit for indicating the tape pressing and transferring position of the head main body. Koyama et al. does not disclose a device in which the rotating operation unit serves also as a head position indicating unit for indicating the tape pressing and transferring position of the head main body or an operation lever projecting through the operation guide to the outside of the case. It is well known and conventional in the mechanical device art, as disclosed by Nishikawa et al. (Figure 1, lever 2), to supply a device with a lever which provides means for moving particular elements contained within the device as well as means for clearly indicating the position of those particular elements. Mendelovich et al. discloses a tape dispensing applicator in which an operation lever projects to the outside of a case through an operation guide in a slit form penetrating through the case of the applicator (column 17, lines 42-48). The inability to clearly identify the position of the coat film transfer head of Koyama et al. would have been readily apparent to one of ordinary skill in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the operation lever of Koyama et al. to allow it to project to the outside of the case; the projection of the lever to the outside of the case providing an easier method for a user to operate the lever actuating device and gauge the position of the transfer head at any given time.

*Allowable Subject Matter*

12. Claims 7, 9, and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

13. The following is a statement of reasons for the indication of allowable subject matter:

As to Claim 7, the prior art of record to Koyama et al. (US 5, 556,469) does not provide any teaching or motivation for a coat film transfer head device including a positioning means having an operation lever provided in a supported portion and a positioning engaging portion in a slit form provided in the cylindrical bearing opposite to an operation guide in a slit form, to be engaged with the operation lever elastically as being held at both sides.

As to Claim 9, the prior art of record to Koyama et al. (US 5, 556,469) does not provide any teaching or motivation for a coat film transfer head device including a positioning means having an operation lever provided in a supported portion and a positioning engaging portion in a slit form provided in the cylindrical bearing opposite to an operation guide in a slit form, and the positioning engaging portion having a width such to be engaged with the operation lever elastically as being held at both sides, and also includes a positioning recess for positioning the operation lever at a specified position in its longitudinal direction.

As to Claim 10, the prior art of record to Koyama et al. (US 5, 556,469) does not provide any teaching or motivation for a coat film transfer head device including positioning means having an engaging bump provided on the cylindrical outer circumference of the supported portion or the cylindrical inner circumference of the cylindrical bearing, and engaging recesses provided at specific intervals in the circumferential direction on the cylindrical inner

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circumference of the cylindrical bearing or the cylindrical outer circumference of the supported portion, and the engaging bump and engaging recess are elastically positioned and engaged.

### ***Response to Arguments***

14. In response to the applicant's amendment of the specification, the Examiner withdraws the objection to the specification.

In response to the applicant's amendment of claims 7 and 9, the Examiner withdraws those objections. It is noted that new objections to claims 7, 9, and 10 have been presented.

In response to the applicant's amendment of claims 2, 9, and 11, the Examiner withdraws all rejections made under 35 USC 112, 2<sup>nd</sup> paragraph.

15. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N. Hawkins whose telephone number is (703) 306-0941. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where the application or proceeding is assigned is (703) 872-9310 for regular communications or (703) 872-9311 for After-Final communications.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone numbers is (703) 308-0661.

Cheryl N. Hawkins

*Cheryl N. Hawkins 11/25/02*

November 25, 2002



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